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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,458	02/28/2002	Haixing Wan	009679-054	4976

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,458

Applicant(s)

WAN, HAIXING

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 01 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

This application is before the examiner for consideration.

A.1. Claims 1-12 are generic to a plurality of disclosed patentably distinct species comprising (1) aerating processing step, (2) adding hydrogen peroxide (3) both aerating processing step and adding hydrogen peroxide, (4) many possible gaseous compositions containing oxygen, (5) not adding any amount of ferric salt of 1,3-propylenediaminetetracetic acid to ferrous salt 1,3-propylenediaminetetracetic acid "prior to the oxidation process", (6) adding an amount of ferric salt of 1,3-propylenediaminetetracetic acid to ferrous salt 1,3-propylenediaminetetracetic acid "prior to the oxidation process", (7) not adding any amount of an additional salt, (8) many additional and possible salts of 1,3-propylenediaminetetracetic acid other than ferrous and ferric salts, (9) not adding an amount of ammonium hydroxide to ferrous salt of 1,3-propylenediaminetetracetic acid complex forming step (a) and (10) adding an amount of ammonium hydroxide to ferrous salt of 1,3-propylenediaminetetracetic acid complex forming step (a). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicant elect item (4) or (8) above, he is further required to elect its sub-species such as air or ammonium.

2. Claims 13-21 are generic to a plurality of disclosed patentably distinct species comprising (1) aerating processing step, (2) adding hydrogen peroxide (3) both aerating processing step and adding hydrogen peroxide, (4) many possible gaseous compositions containing oxygen, (5) not adding any amount of ferric salt of 1,3-propylenediaminetetracetic acid to ferrous salt 1,3-propylenediaminetetracetic acid "prior to the oxidation process", (6) adding an amount of ferric

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salt of 1,3-propylenediaminetetracetic acid to ferrous salt 1,3-propylenediaminetetracetic acid “prior to the oxidation process”, (7) not adding any amount of an additional salt, (8) many additional and possible salts of 1,3-propylenediaminetetracetic acid other than ferrous and ferric salts, (9) not adding an amount of ammonium hydroxide to ferrous salt of 1,3-propylenediaminetetracetic acid complex forming step (a) and (10) adding an amount of ammonium hydroxide to ferrous salt of 1,3-propylenediaminetetracetic acid complex forming step (a), (11) any percent of ferric salt 1,3-propylenediaminetetracetic acid and (12) at least 80% of ferric salt 1,3-propylenediaminetetracetic acid is manufactured by the oxidation process. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicant elect item (4) or (8) above, he is further required to elect its sub-species such as air or ammonium.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed. If applicant elect item (4) or (6) above, he is further required to elect its sub-species such as air or ammonium.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. Claims 1-12, drawn to a method of making a salt of an organic acid, classified in class 562, subclass 400.
- II. Claims 13-21, drawn to a photographic bleaching process, classified in class 430, subclass 430.

Inventions of Group I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination of the main invention of Group I, claims 1-12 being related to a method of making a compound, can be separately stood by itself for a patentability as set forth on the record and the main invention of Group II, claims 13-21 being related to a method of bleaching a developed photographic material, can also be separately stood by itself for a patentability as set forth on the record. The subcombination has separate utility such as such as an iron source additive in food or vitamin product. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

The inventions of Group I and Group II are all related to the processes but have the patentably different and distinct processing steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that they are not required the separate consideration and search since they are the obvious variants because the prior art being applied to the main invention of Group I,

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claims 1-12 being related to a method of making a compound alone is also sufficient against the invention of the main invention of claims 13-21 since the use of the ferric salt of propylenediaminetetraacetic acid as a bleaching agent for a developed photographic material is conventional and well known in the art and no consideration or search in class 430, sub class 393 and 430 is required, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

C. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

D. The independent claims 1 and 14 are considered as the main inventions, the dependent claims of such independent claims are the secondary additive embodiments. The dependent claims (2-12) or (13 and 15-21) will be let to be rejoined with an elected main invention of the

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independent claims 1 or 14 when the elected main invention of claims 1 or 14 is considered, searched and found to be allowable.

E. The abbreviation "PDTA" in the claims is in proper. Applicant is requested and required to fully spell out its full term at least in first appeared claim such as in its independent claim in the instant case. It is reminded that although a claim is read in light of the specification when it is in a doubt. However, the claim must be self completed where it is possible.

F. Information Disclosure Statement filed on 18 June 2002 has been entered in the file only.

G. Other issues have not been considered until a proper election is made and resolved.

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
January 13, 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le